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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,210	12/01/2003	Andreas Seidel	PO-7824/LcA 36,084	4685
157	7590	06/10/2005	EXAMINER	
BAYER MATERIAL SCIENCE LLC 100 BAYER ROAD PITTSBURGH, PA 15205			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 06/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,210

Applicant(s)

SEIDEL ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1712

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5,7 and 14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 lists (meth)acrylic acid esters as possibly being 50-99 parts of the shell, but later limits (meth)acrylic acid esters to 1-50 parts. The two limitations are inconsistent. Which is intended?

Isatinbiscresol is believed to have only two phenolic groups. Therefore, claim 7's isatinbiscresol cannot qualify as the trifunctional phenolic of claim 1.

Claim 14 cannot depend on itself. Furthermore, "C1-C8 alkyl, substituted by an alkyl" is not understood. Normally, this would be considered a branched alkyl. Is the entire branched alkyl limited to eight carbons?

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country; more than one year prior to the date of application for patent in the United States.

Art Unit: 1712

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3-6,8-10 and 20-22 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kozakura '949.

Kozakura exemplifies ((table 1-5) blends of branched polycarbonate, polyester and paraloid KM330. The branching agent is tris (hydroxyphenyl)ethane. Paraloid KM330 is a graft upon an acrylic rubber (col 5 line 30-37). Flame retardants (col 7 line 56), acrylonitrile/styrene resins etc (col 7 line 68) can be included. The molecular weights of the reference polycarbonate (15,000-40,000 col 3 line 30) appears to correspond to the relative viscosities of applicant's claim 10 based on the known relationship between Mw and viscosity.

Claims 1,3-6 and 8-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Kozakura '949 in view of Koyama '570 or Ogo'432.

Kozakura suggests flame retardants can be included but does not name any species thereof.

Both Koyama and Ogoe (see tables) show phosphates + PTFE effectively flame retard blends of polycarbonate and polyester. It would have been obvious use phosphates and PTFE as the flame retardants in Kozakura's composition.

Claims 1,3-6 and 8-22 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J2001226576.

The reference is believed to exemplify (#4,5,8,9,15,17) blends of branched polycarbonate, metablen S2001, a vinyl copolymer, a phosphate flame retardant and PTFE. Metablen S2001 is a graft of methylmethacrylate on a siloxane/acrylate rubber and is one of applicant's preferred grafts (page 22 line 27). The examples do not specify what the branching agent was, but the reference suggests a number of possible branching agents including a triphenol – see formula (3')-(b). Use of this branching agent would have been obvious if not considered anticipatory.

Claims 1,3-6 and 8-22 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van Den Helder WO 99/57198.

The reference claims (#4) blends of branched polycarbonate, a grafted rubber, a phosphate flame retardant and a fluoropolymer drip retardant. The base of the graft can be acrylic (page 10 line 10-15). The branching agent can be a triphenol (page 4 line 23). Use of any combination of elements suggested by the reference would have been obvious if not considered anticipatory.

Claims 1-22 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Itagaki '766.

Itagaki exemplifies blends of polycarbonate, metablen S2001, phosphate flame retardant and PTFE. Although the examples' polycarbonate is not branched, Itagaki (col 3 line 63) teaches a polycarbonate branched with isatinbiscresol can be employed. Use of such a branched polycarbonate would be obvious if not considered anticipatory.

Claims 1-22 rejected under 35 U.S.C. 102(a,e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Seidel 2003/0153658.

Seidel exemplifies blends of isatinbiscresol branched polycarbonate, phosphate, ABS, PTFE and SAN ((table 1). Other grafted rubbers can be used instead of ABS (paragraph 83). It would have been obvious if not considered anticipatory to use non-polybutadiene based grafts.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6838518. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims blends of branched polycarbonate, phosphate and grafted rubber. The graft base can be rubbers other than polybutadiene (claim 14 of patent). It is clear from the patent's examples that the branching agent can be isatinbiscresol (col 11 line 30).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner
DAVID J. BUTTNER
PRIMARY EXAMINER

6/6/05

David Buttner